

REMARKS

Claims 16-41 are pending in the above application.

The Office Action dated March 9, 2006, has been received and carefully reviewed. Reconsideration and allowance of claims 16-41 is respectfully requested in view of the following remarks.

PREMATURE FINALITY OF OFFICE ACTION

It is respectfully submitted that the finality of the March 9, 2006, Office Action is premature, because the Office Action fails to address the arguments presented in the previous Office Action. In connection with claims 16-38, Applicant argued that a proper motivation for combining the references had not been provided. The present rejections of claims 16-38 appear to be identical to the rejections in the first Office Action. In addition, these "Response to Arguments" section of the Office Action substantially repeats these rejections with minor wording changes.

It is submitted that paraphrasing the original rejection does not constitute a response to Applicant's previous arguments. As provided by Section 707.07(f) of the MPEP:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

It is respectfully submitted that the record does not show why one skilled in the art would be motivated to make the combination used by the examiner in rejecting claims 16-38; repeating the rejection does not make the rejection any clearer. If the examiner addresses the previous

arguments, Applicant will be in a better position to understand the basis for the rejections and determine whether an appeal is necessary. Alternately, if the arguments cannot be addressed, it is respectfully submitted that claims 16-38 should be allowed. It is therefore respectfully requested that the finality of the current Office Action be withdrawn and that a new Office Action in which Applicant's arguments are addressed be issued.

A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN PROVIDED

As argued in the previous Reply, a proper motivation for combining Yoshimura and Sakaegi in rejecting claim 16 has not been provided. The rejections in the present Office Action describe elements of Yoshimura, describe elements of Sakaegi and conclude that it would be obvious to combine the references because the combination would allegedly produce a benefit. With the improper use of hindsight, it is generally possible to find a "benefit" of combining any two references. However, nothing in the record shows why one skilled in the art would have been motivated to make the combination and achieve a benefit before seeing the present disclosure. The fact that the modification may be useful in hindsight is not sufficient to show why one not aware of the present disclosure would have found it desirable to make the combination in the first place. A proper motivation for combining Yoshimura and Sakaegi has not been provided, a *prima facie* case of obviousness has not been presented, and it is therefore submitted that claim 16 is in condition for allowance.

Claims 17-27 depend from claim 16 and are submitted to be allowable for the same reasons as claim 16.

To the extent that the rejections of claims 28-41 are based on a combination of Yoshimura and Sakaegi, these rejections are also traversed on the grounds that a proper motivation for combining these references has not been provided.

Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi and further in view of Mincy. The only reason provided for combining Mincy with Yoshimura and Sakaegi is a statement of a benefit that would allegedly occur if the combination were made. This does not constitute a motivation for combining references and does not present a *prima facie* case of obviousness. Claims 39-41 are therefore submitted to

patentably distinguish over the references of record.

THE REFERENCES, EVEN IF COMBINED, DO NOT SHOW OR SUGGEST THE CLAIMED INVENTION

Even if a motivation for combining the references were provided, it is respectfully submitted that the combination would not render the claimed invention obvious. Claim 16, as amended, requires a recording device that includes, *inter alia*, a communication portion communicating with an external apparatus and a “command executing portion interpreting a command received from the external apparatus and transmitting [certain information] through said communicating portion.” The Office Action acknowledges that Yoshimura does not show a communicating portion communicating with an external apparatus. Sakaegi is cited to show a communicating portion, specifically, remote control 36. It is respectfully submitted that if remote control 36 corresponds to a communicating portion, then no external apparatus is disclosed is Yoshimura or Sakaegi, and that claim 16 is allowable over these references.

It appears possible that the remote control is being interpreted as an external apparatus and that Sakaegi’s “reception 38” of Figure 1 or “light receiving 126” of Figure 13 is being interpreted as a communication portion. However, even under this interpretation, “one or a plurality of the still image, the video and the information” is not being transmitted through said communication portion as required by claim 16. Thus, it is respectfully submitted that even if a motivation for combining Yoshimura and Sakaegi is provided, the result does not show or suggest the invention required by claim 16 as amended. Claim 16 is therefore submitted to be allowable over Yoshimura and Sakaegi.

Claims 17-27 depend from claim 16 and are submitted to be allowable for at least the same reasons as claim 16. Claim 26 further distinguishes over the art of record by requiring that a still image portion cuts out and records the still image by detecting a switching of a sound multiplex mode. The Office Action cites to a new portion of Yoshimura to support the present rejection, but this section of the reference, like the previously cited portion of the reference, makes no mention of sound, much less a sound multiplex mode. While “frequency” and “multiplexing” are mentioned in both cited locations, sound is not in any manner being

discussed. No detecting of a switching mode, much less a detecting of a switching of a sound multiplex mode is disclosed. Claim 26 is submitted to further distinguish over the art of record for this reason.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi. Claim 28 requires a communicating portion communicating with an external apparatus. Moreover, a still image display portion is received through this communicating portion and a video display portion is received through this communicating portion. The Office Action indicates that remote control 112 of Sakaegi corresponds to the claimed communicating portion. However, still images and videos are not received through remote control 112. If the Office Action is interpreting Sakaegi's remote control as an external device, then the Office Action may be interpreting either "reception 38" or "light receiving 126" as a communicating portion. However, even under this interpretation, neither of these "communicating portions" receive a still image display portion or a video display portion as required by claim 28. Thus even if a motivation for combining Yoshimura and Sakaegi were provided, the result would not be the invention required by claim 28. Claim 28 and its dependent claims 29-38 are submitted to be allowable for at least this reason.

Claim 39 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi and further in view of Mincy. Even if a motivation for combining Yoshimura, Sakaegi and Mincy were provided, the result would not be the invention required by claim 39.

Specifically, claim 39 does not show or suggest a recording device and a reproducing device connected through a network. No reproducing device is illustrated in Figure 4 of Mincy. Figure 5 and column 9 lines 55-63 of Mincy discuss reproducing devices such as a viewfinder and a monitor, but there is no suggestion that the viewfinder or monitor be connected to the recording device by a network. Therefore, even if a motivation for combining the references is provided, the result would not be the invention required by claim 39. Claim 39 is submitted to be allowable over the references of record for at least this reason.

Claims 40 and 41 are submitted to be allowable for at least the same reasons as claim 39.

CONCLUSION

Each issue raised in the Office Action dated March 9, 2006, has been addressed, and it is believed that claims 16-41 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

Charles Gorenstein

Registration No.: 29,271

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant